

Docket Number: 10006447-1
Application No. 09/995,900
Amendment B

REMARKS/ARGUMENTS

Claims 9 – 17, 21, and 24 – 26 are in the application, with claims 24 - 26 being newly added. Reconsideration is respectfully requested.

Rejections under Section 102 (35 USC § 102(b))

Independent claims 9 and 16 were rejected as anticipated by Yoshizawa.

Claim 9 recites, in part, a proximity sensor that is configured “*to measure the extent of deflection of the shim.*” The shim is configured to deflect as print medium passes between the shim and the drive medium against which the shim is biased.

The Examiner refers to an upper guide 23 in Yoshizawa (Fig. 1) and identifies that as the claimed shim. Applicant notes, however, that Yoshizawa does not contemplate measuring deflection of the shim. Rather, the sensor 22 of Yoshizawa (Fig. 2) measures the distance to a lower guide 24 in the instance where there is no print medium moving through the upper and lower guides.¹ As explained in the paragraph bridging columns 5 and 6 of Yoshizawa, this measurement of the apparently fixed lower guide plate provides a baseline or calibration number so that when print medium is located between the upper and lower guides, the sensor will measure the distance to the print medium (Fig. 1) and the processor associated with the sensor can determine the thickness of the medium as the difference between these sensed distances.

As clearly shown in Fig. 2 of Yoshizawa, and consistent with the disclosure just summarized, the sensor of Yoshizawa does *not* measure any shim deflection. The beam emitted from the Yoshizawa sensor passes between the two parts of the movable “shim” 23 so that the above mentioned baseline measurement can be made.

Accordingly, Yoshizawa fails to disclose or suggest a sensor that is configured to measure the extent of deflection of a biased shim as claimed.

The MPEP makes it clear that “*to anticipate a claim, the reference must teach every element of the claim.*” (MPEP § 2131) Quoting Federal Circuit Court opinions, the MPEP continues:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal*

¹ The upper and lower guides in Yoshizawa serve to sandwich print media between them in order to suppress flutter of the medium (Col. 5, lines 50 – 57).

Docket Number: 10006447-1
Application No. 09/995,900
Amendment B

Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In view of the foregoing explanation of how Yoshizawa fails to disclose at least one element of claim 9, the rejection of that claim, and the claims depending therefrom, should be withdrawn.

Claim 16 has been amended to more clearly point out that the claimed proximity sensor is integral with the shim, thereby "*to move with the shim.*" One embodiment of this appears in Fig. 5 of the present application. Upon review of that figure and the associated text in the specification, one of ordinary skill will understand that the integrated shim and sensor move together when as print media 90 passes by. Nothing in Yoshizawa contemplates this integrated configuration.

Claim Rejections Under 35 USC §103

In other grounds for rejecting claim 9, the Examiner combined Kataoka with Yoshizawa to apply an obviousness rejection. In formulating the rejection, the Examiner noted (page 9 of the Detailed Action) that Kataoka does not teach a "*shim biased against the print medium drive mechanism and configured to deflect ... as the print medium passes between the shim and print medium drive mechanism.*" The Examiner then concludes the Yoshizawa provides a deflecting shim, and that it would be obvious to use the Yoshizawa shim in Kataoka because "*Yoshizawa teaches that such a shim is beneficial for detecting the thickness [of conveyed print medium].*"

In reply, applicant notes that the only deflecting shim in Yoshizawa is the upper guide 22. The lower guide 24 identified as the claimed shim by the Examiner apparently does not move and instead is relied upon to provide a baseline or datum measure for paper thickness. The upper guide 22 in Yoshizawa plays no role in print medium thickness measure. Indeed, the guide 22 is split so that it does not affect the direct measurement of the print medium surface (hence the medium thickness calculation). Moreover, as noted earlier, the function of the upper guide 22 of Yoshizawa is expressly stated as suppressing fluttering of the print medium (Col. 5, lines 51 – 57) that is conveyed in the Yoshizawa system.

Accordingly, Yoshizawa neither teaches nor suggests the use of a deflecting shim for print media thickness measure that is missing from Kataoka. Accordingly, applicant submits

Docket Number: 10006447-1
Application No. 09/995,900
Amendment B

that a *prima facie* case of obviousness has not been made, and the associated rejection of claim 9 and the claims depending therefrom should be withdrawn. (MPEP § 2143)

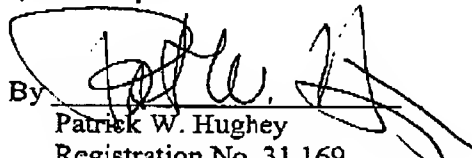
Amended independent claim 17 is a method claim that is closely analogous to apparatus claim 9. Applicant submits that for the reasons set forth above with respect to claim 9, the rejections of claim 17 should also be withdrawn.

New claims 24 - 26 have been added here to particularly point out additional aspects of the invention.

Conclusion

In view of the foregoing, applicant believes that all of the currently pending claims are in condition for allowance, and an early notification to that effect is respectfully requested. If the Examiner has any questions, he is invited to contact applicant's attorney at the below-listed telephone number.

Respectfully submitted,
ipsolon llp

By 
Patrick W. Hughey
Registration No. 31,169
Tel. No. (503) 419-0704

Please address all correspondence to:
Hewlett Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400